

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MICHAEL MULLER and ANDREW L. SCHIRMER

Appeal 2012-007703
Application 11/967,627
Technology Center 3600

Before ANTON W. FETTING, MICHAEL W. KIM, and
NINA L. MEDLOCK, *Administrative Patent Judges*.

FETTING, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE¹

Michael Muller and Andrew L. Schirmer (Appellants) seek review under 35 U.S.C. § 134 of a final rejection of claims 1–23, the only claims pending in the application on appeal. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

¹ Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed December 19, 2011) and Reply Brief ("Reply Br.," filed April 16, 2012), and the Examiner's Answer ("Ans.," mailed February 15, 2012) and Final Office Action ("Final Act.," mailed July 15, 2011).

The Appellants invented “a . . . method, system and computer program product for live intention management in a computer communications network.” (Spec. para. 6).

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below (bracketed matter and some paragraphing added).

1. A live intention management method, the method comprising:

[A] selecting a serviceable object in a service area;

[B] changing live intention metadata data for the selected serviceable object to reflect an awareness state of the serviceable object indicating that an actor intends to service but has not yet serviced the serviceable object; and,

[C] displaying the serviceable object and the awareness state in a map in a graphical user interface.

REJECTIONS AND REFERENCE

The Examiner relies upon the following prior art in rejecting claims 1–23:

Howard	US 2002/0032733 A1	Mar. 14, 2002
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Claims 1–10 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

Claims 1–23 stand rejected under 35 U.S.C. § 102(b) as anticipated by Howard.

ISSUES

The issue of whether the claims recite ineligible subject matter turns on whether the method claims fall under the exception that prevents patenting of abstract ideas.

The issue of anticipation turns on whether the Abstract of Howard discloses the claimed steps of selecting, changing, and displaying.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Facts Related to Claim Construction

01.The disclosure contains no lexicographic definition of “graphical user interface.”

Facts Related to Appellants’ Disclosure

02.The Specification describes embodiments where a “graphical user interface” is an element of a computer system. (Spec. para. 19).

03.The Specification describes that the “live intention management process described herein can be performed in a service dispatch data processing system.” (Spec. para. 22).

Facts Related to the Prior Art

Howard

04.Howard is directed to “an automated system for predicting conflicts among issued instructions based on the issuer’s intent,

and notifying the appropriate users of the potential conflicts.”
(Howard, para. 2).

05. Howard discloses “[i]nput devices such as satellites, field sensors, electronic pads, cellular phones, and/or radio transmitters.”
(Howard, Abstract).

06. Howard discloses “an input module for processing the information received from the input devices.” (Howard, Abstract).

07. Howard discloses “a language converter for converting the information from a natural language format to a restructured form in a position based format.” (Howard, Abstract).

08. Howard discloses its “analyzer sends an alert to the user interface to notify the user if execution of one the instructions creates a potential conflict.” (Howard, Abstract).

ANALYSIS

Claims 1–10 rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter

We are not persuaded by the Appellants’ argument that the claims recite eligible subject matter, because the Examiner has relied only upon the claims’ failure to satisfy the *Bilski* machine-or-transformation test² as a basis for concluding the claims recite an abstract idea. (App. Br. 5–8, Reply Br. 2–3).

² See *Bilski v. Kappos*, 561 U.S. 593 (2010).

—Since *Bilski*, the Supreme Court

set forth a framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts. First, [] determine whether the claims at issue are directed to one of those patent-ineligible concepts. [] If so, we then ask, “[w]hat else is there in the claims before us? [] To answer that question, [] consider the elements of each claim both individually and “as an ordered combination” to determine whether the additional elements “transform the nature of the claim” into a patent-eligible application. [The Court] described step two of this analysis as a search for an “‘inventive concept’”—i.e., an element or combination of elements that is “sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.”

Alice Corp. Pty. Ltd. v CLS Bank Intl., 134 S. Ct. 2347, 2355 (2014) (citing *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S. Ct. 1289 (2012)).

To perform this test, we must first determine whether the claims at issue are directed to a patent-ineligible concept.

The preamble to claim 1 recites that it is a method of managing intention. The adjective “live” adds little to this, as live as an adjective may simply mean current or instant. The three steps in claim 1 result in displaying an object and map somehow related to intent. The Specification paragraph 1 recites that the invention relates to event management for service dispatch. The Specification paragraph 6 goes on to disclose this is done by intent management. Thus, all this evidence shows that claim 1 is directed to managing intent.

As in *Alice Corp. Pty. Ltd.*, we need not labor to delimit the precise contours of the “abstract ideas” category in this case. It is enough to

recognize that there is no meaningful distinction in the level of abstraction between the concept of risk hedging in *Bilski* and the concept of managing intention at issue here. Both are squarely within the realm of “abstract ideas” as the Court has used that term. *See Alice Corp. Pty. Ltd.*, 134 S. Ct. at 2357. Intention per se, being a precursor thought, is the epitome of abstraction. Managing that thought, even by displaying it, is yet more thought with some visual representation, as in doodling.

The remaining claims merely describe examples of selecting objects and altering data. We conclude that the claims at issue are directed to a patent-ineligible concept.

The introduction of a computer into the claims does not alter the analysis at *Mayo* step two.

the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. Stating an abstract idea “while adding the words ‘apply it’” is not enough for patent eligibility. Nor is limiting the use of an abstract idea “to a particular technological environment.” Stating an abstract idea while adding the words “apply it with a computer” simply combines those two steps, with the same deficient result. Thus, if a patent’s recitation of a computer amounts to a mere instruction to “implement[t]” an abstract idea “on . . . a computer,” that addition cannot impart patent eligibility. This conclusion accords with the preemption concern that undergirds our §101 jurisprudence. Given the ubiquity of computers, wholly generic computer implementation is not generally the sort of “additional feature[e]” that provides any “practical assurance that the process is more than a drafting effort designed to monopolize the [abstract idea] itself.”

Alice Corp. Pty. Ltd., 134 S. Ct. at 2358 (citations omitted).

“[T]he relevant question is whether the claims here do more than simply instruct the practitioner to implement the abstract idea [] on a generic computer.” *Alice Corp. Pty. Ltd.*, 134 S. Ct. at 2359. They do not.

Taking the claim elements separately, no function is explicitly performed by a computer. The closest is the recitation of a graphical user interface, but a paper notepad is one of those.

Considered as an ordered combination, the limitations of Appellants’ method add nothing that is not already present when the steps are considered separately. Viewed as a whole, Appellants’ method claims simply recite the concept of managing intention. Even were the steps implied as being performed on a computer, the method claims do not, for example, purport to improve the functioning of a computer itself. Nor do they effect an improvement in any other technology or technical field. Instead, the claims at issue amount to nothing significantly more than an instruction to apply the abstract idea of managing intent using some unspecified, generic graphical interface. Under our precedents, that is not enough to transform an abstract idea into a patent-eligible invention. *See Alice Corp. Pty. Ltd.*, 134 S. Ct. at 2360.

Claims 1–23 rejected under 35 U.S.C. § 102(b) as anticipated by Howard

The Appellants argue independent claims 1, 11, and 14 as a group (App. Br. 14, Reply Br. 4). We select claim 1 as representative. The Appellants do not argue dependent claims 2–10, 12, 13, and 15–23 with specificity, so claims 2–23 stand or fall with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2011).

We are not persuaded by the Appellants' arguments that the Examiner has failed to provide sufficient explanation to substantiate the rejection of the claims under 35 U.S.C. § 102(b). (App. Br. 8–16, Reply Br. 4–7).

In *In re Jung*, 637 F.3d 1356 (Fed. Cir. 2011), the Federal Circuit held that, during prosecution, an examiner is governed by 35 U.S.C. § 132, which requires notification to an applicant of the reasons for a rejection with “such information and references as may be useful in judging of the propriety of continuing the prosecution of [the] application.” *Jung*, 637 F.3d at 1362 (quoting 35 U.S.C. § 132). However, the court made clear that section 132 does not mandate that in order to establish a prima facie case, an Examiner must make an on-the-record claim construction of every term in every rejected claim or explain every possible difference between the prior art and the claimed invention. *Id.* at 1363. Instead, the statute only requires that “an applicant at least be informed of the broad statutory basis for the rejection of his claims, so that he may determine what the issues are on which he can or should produce evidence.” *Id.* (quoting *Chester v. Miller*, 906 F.2d 1574, 1578 (1990)).

Here, the Examiner notified Appellants that claim 1 is rejected under 35 U.S.C. § 102(b) as anticipated by Howard, and the Examiner cited specific portions of Howard (citing the Abstract and Figures 1–5), that are the bases for the rejection (*see* Ans. 7 and 12–14).

We find that the Examiner's rejection satisfies the notice requirement of § 132, and, therefore, establishes a prima facie case of unpatentability. *Cf. Jung*, 637 F.3d at 1363 (“[T]he examiner's discussion of the theory of invalidity . . . the prior art basis for the rejection . . . and the identification of

where each limitation of the rejected claims is shown in the prior art reference by specific column and line number was more than sufficient to meet this burden.”). Therefore, the burden shifts to Appellants to rebut the Examiner’s prima facie case by distinctly and specifically pointing out the supposed errors in the Examiner’s action, as well as the specific distinction believed to render the claims patentable over the cited reference. *See* 37 C.F.R. § 41.37(c)(vii) (2011) (“A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.”); *see also In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011) (“[W]e hold that the Board reasonably interpreted Rule 41.37 to require more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art.”).

Howard discloses “selecting a serviceable object in a service area” when it receives data from one of its input devices (FF 05, 06), discloses “changing live intention metadata data for the selected serviceable object” when it uses “a language converter” on the received data (FF 07), and discloses “displaying the serviceable object and the awareness state in a map in a graphical user interface” when it “sends an alert to the user interface to notify the user” (FF 08). Thus, the Abstract of Howard meets the claim language of claim 1.

For these reasons, we affirm the rejection of claims 1–23 under 35 U.S.C. § 102(b).

CONCLUSIONS OF LAW

The rejection of claims 1–10 under 35 U.S.C. § 101 as directed to non-statutory subject matter is proper.

The rejection of claims 1–23 under 35 U.S.C. § 102(b) as anticipated by Howard is proper.

DECISION

The rejections of claims 1–23 are affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2011).

AFFIRMED

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